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WM. R. STANSB
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IN THE

Supreme Court of the United States

OCTOBER TERM—1924.

No. ~~412.~~ 107

THE ALEXANDER MILBURN COMPANY,
Petitioner,

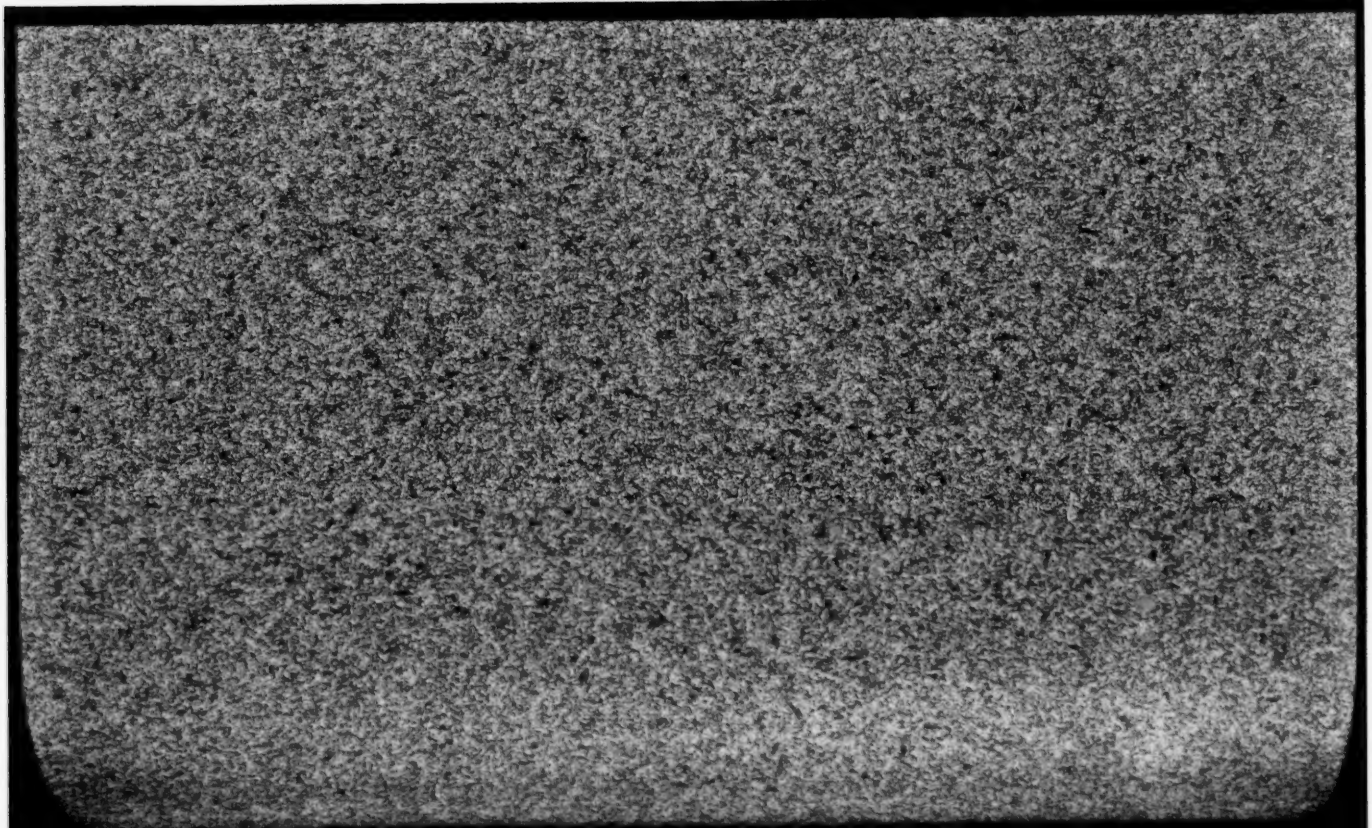
vs.

DAVIS-BOURNONVILLE COMPANY,
Respondent.

BRIEF FOR RESPONDENT ON PETITION FOR WRIT OF CERTIORARI.

DEAN S. EDMONDS,
Solicitor for Respondent.

Gallo & Ackerman, Inc., 107 Liberty Street, N. Y.



Supreme Court of the United States

OCTOBER TERM, 1924.

No. 472.

THE ALEXANDER MILBURN COMPANY,
Plaintiff,

vs.

DAVIS-BOURNONVILLE COMPANY,
Respondent.

BRIEF FOR RESPONDENT.

The record in this case presents a matter of fact which is not mentioned in the petition and which is of controlling importance.

The Harlan A. Clifford referred to as the patentee of patent No. 1,016,613 (Rec., page 658) was in the employ of the respondent (plaintiff) company at the time his invention was made (Rec., pages 143-4, Qs9-14). Whitford, the patentee of the patent in suit, was also in the employ of the company. These two men probably worked side by side month after month, familiar with all the problems that confronted the company in the

development of its business and each fully cognizant of what the other did or suggested by way of solution of those problems. That was prior to 1911, when the oxy-acetylene torch was far from its present highly-developed state; at that time problems were plentiful and the shop of respondent where Clifford and Whitford worked day after day was probably the greatest center of activity in solving them.

Clifford produced the form of torch shown in his patent. He had a certain definite purpose in view and he devised a construction which achieved that purpose. Then he applied for a patent and in the specification of the patent he set forth fully what his purpose was, described his construction and pointed out how that construction attained that purpose.

Whitford's effort was along distinctly different lines. When the specifications of the Clifford and Whitford patents are compared, it is apparent that there is no suggestion of a conflict between them. Also, when the claims are compared, it is equally clear that each made claim to an invention quite distinct from that claimed by the other.

One of the points urged by defendant in this case is based on the alleged fact that the construction illustrated and described in the Clifford patent embodies the inventive idea described in the Whitford patent as having been originated by Whitford, and claimed in the Whitford patent as of Whitford's invention. Clifford did not state that it was of his invention and he did not claim it, either in his patent or anywhere else. He as-

serted in his patent that his invention was something distinctly different, something which he did claim, and he described a construction which, if it embodies Whitford's invention, does so merely as an incident to disclosing his own invention. It is probable that Clifford was entirely familiar with what Whitford had devised and that his whole effort was to carry Whitford's accomplishment forward one further step; that would explain fully his illustration and description of a construction which may now seem to embody Whitford's invention and his statement and claim, made at the time, that his own invention lay in certain special features which distinguished his torch from all others.

It so happens, for some reason not explained in the record and probably not now explainable, that Clifford's application for patent was placed on file in the Patent Office 34 days before Whitford's was filed; January 31, 1911, for Clifford, and March 4, 1911, for Whitford. The petition for *certiorari* is based wholly upon that. It asks the Court to assume, from the single circumstance that Clifford's application was 34 days prior in date of filing, that Clifford was the inventor of what Whitford claims, although Clifford does not say he was the inventor of it and does say he was the inventor of something else, and although Clifford undoubtedly knew, just as well as Whitford and better than anyone else, exactly what it was that he invented and exactly what it was that Whitford invented. Petitioner asks the Court to assume this from one single item of evidence, namely, a certified copy of the

application for the Clifford patent whose sole purpose and function was and is to establish the date, January 31, 1911, when the application for the Clifford patent was filed.

We say in reply that this document alone, serving only to fix a date about which there never was any controversy, should not give rise to an assumption, and justify action on an assumption, that Clifford was the original inventor of something which he has never asserted was invented by him, something described incidentally in his patent though not stated to be his invention and not covered by any claim. Otherwise stated, we say that an assumption that Clifford was the inventor of a certain invention is not justified by a document in which Clifford said he was the inventor of some other invention.

The petition is correct in its statement on page 3 that the only defense involved is that of prior invention, that is, that Clifford made the invention described and claimed in the Whitford patent in suit before Whitford made it. It is also correct in its statement on that same page with respect to the proof on which that defense rests, namely, that it consists of a single document consisting of a record of the proceedings in the Patent Office which led up to the grant of the Clifford patent.

That one document is offered as proof that Clifford was the first inventor of the particular invention involved in this suit, although it is a document in which Clifford states, as plainly as words can state it, that he was the inventor of a distinctly different invention.

The Court is requested by petitioner to assume that Clifford did not know what he had invented and that what was stated to be his invention and was claimed in his patent was wholly fortuitous or the selection of his attorney. Proceeding from that, the Court is requested by petitioner to assume that Clifford was the inventor of every novel feature of the construction illustrated in the drawings of his patent, irrespective of whether or not he said so, and that he had a full appreciation of the value of features of torch construction other than those which he stated were of value and claimed as of his invention.

We question whether such an assumption should be made in any case; but certainly no such assumption would be justifiable in a case like the present one where the fact is that the two patentees worked together side by side under the same roof and on the same problems. It is far more reasonable and sensible to assume that each knew what the other had done, that each knew what his own contribution to the art was, and that each told his patent attorney what he had invented and what he wanted a patent for and what to say was his invention and what to claim as his invention.

That being so, the question of law stated in the petition does not apply to the facts here presented. No case has been cited in the petition, or elsewhere in the progress of this suit, paralleling the facts of this case.

We submit, therefore, that the petition for *certiorari* should be denied.

Respectfully submitted,

DEAN S. EDMONDS,
Solicitor for Respondent.

DEAN S. EDMONDS,
J. H. BRANDENBURG,
E. H. MERCHANT,
of Counsel.

New York, N. Y., September 21, 1924.